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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/453,800      | 12/03/1999  | ANDREW WATSON        | CIT101125           | 3066             |

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KILPATRICK STOCKTON LLP  
607 14TH STREET, N.W.  
WASHINGTON, DC 20005

EXAMINER

KARMIS, STEFANOS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3624

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



## Office Action Summary

Application No.

09/453,800

Applicant(s)

WATSON, ANDREW

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following communication is in response to Applicant's amendment filed on 07 October 2004.

#### ***Status of Claims***

2. Claims 1, 14 and 18 are currently amended. Claims 2-13, 15-17 and 19-21 are left as originally filed. Therefore claims 1-21 are under prosecution in this application.

#### ***Summary of this Office Action***

3. Applicant's response filed on, 07 October 2004, has been fully considered and is discussed in the next section below or within the following rejection. Claims 1-21 have been rejected based on the art cited below and Applicant's request for allowance is respectfully declined.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 14-17 remain rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (hereinafter Walker'478) U.S. Patent 5,970,478.

Claims 14-17 were rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (hereinafter Walker'478) U.S. Patent 5,970,478 as stated in the previous office action mailed 07 April 2004. Regarding claim 14, Applicant has amended the claim to include "a checker module for determining worthiness parameters in real time in conjunction with a credit rating entity external to the computer system and suggests that Walker'478 fails to establish this limitation. The Examiner respectfully disagrees. Walker'478 teaches a computer system with a modem for outside communication to bank agent terminals (Figure 2). Further, Walker'478 teaches credit rating stored in a consumer database in which the credit rating may be obtained from such external reporting agencies as TRW or EQUIFAX (column 6, lines 29-47). Therefore Walker'478 does teach a credit rating entity external to the computer system to determine worthiness parameters and a manner for communication with the external credit rating agencies.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-13 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (hereinafter Walker'478) U.S. Patent 5,970,478 in view of Walker et al (hereinafter Walker'534) U.S. Patent 6,434,534.

Claims 1-11 and 14-21 were rejected under 35 U.S.C. 102(e) as being unpatentable over Walker et al. (hereinafter Walker'478) U.S. Patent 5,970,478 as stated in the previous office action, mailed 07 April 2004. Regarding claim 1, Applicant has amended the claim to include

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the limitation “wherein the baseline offer includes at least one benefit from an entity other than the account issuer.” Walker’478 teaches providing a baseline offer for a first account service (column 8, lines 6-20) as well as a parameter database which include such parameters as interest rate, credit limit and monthly minimum payments (column 5, lines 38-51). Walker’478 further teaches that the parameters in the database are not limited to those parameters (column 6, lines 7-11). Therefore Walker’478 fails to teach that the baseline offer includes at least one benefit from an entity other than the account issuer. Walker’534 teaches a method and system for processing customized rewards in which options such as frequent flyer miles, magazine subscriptions and other available incentives are included as a credit card parameter to a customer when issuing a credit card (column 6, lines 46-56). These include benefits from an entity other than the account issuer. Further, Walker’534 teaches card holder input in determining the reward terms (column 9, lines 25-34). Therefore it would have been obvious to one of ordinary skill in the art, that the baseline offer teachings of teachings of Walker’479 could have been modified to include the parameter specifics of Walker’534 because the terms are all credit card parameters adjusted to a card holders preference to encourage the card holder to accept and be active with the account. Further, Walker’478 also references credit cards, which provide a benefit from an entity other than the account holder (column 1, lines 26-45).

10. Regarding claims 12 and 13, Applicant has challenged the Official Notice and has asked for support from the Examiner. The Examiner had provided Official Notice that managing accounts such as insurance or telecommunications accounts is old and well known in the financial arts. U.S. Patent 6,386,444 to Sullivan teaches a system and method for card payment

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instrument with rebate applied to an insurance premium. U.S. Patent 5,915,006 to Jagadish et al. teaches a telephone line aggregated billing. Both Sullivan and Jagadish et al. manage accounts with the intent to increase customer involvement and tailor the parameters of the account to the customer of the account.

11. Independent claim 18 follows reasoning similar to that of claim 1 addressed above and therefore the rejection follows the same reasoning. Any remaining claims are either addressed above or stand rejected as stated in the previous office action, mailed 07 April 2004. Therefore claims 1-21 stand rejected and Applicant's request for allowance is respectfully declined.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-21 are considered moot in view of the new grounds of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (703) 305-8130. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted  
Stefano Karmis  
06 January 2005



HANI M. KAZIMI  
PRIMARY EXAMINER